

PATENT

ATTORNEY DOCKET No. 104.005-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ken R. POWELL

Filed: February 1, 2000

Serial No. 09/495,483

For: SYSTEM AND METHOD FOR  
PROCESSING DISCOUNTS USING  
PORTABLE UNITS CARRIED BY  
CUSTOMERS

Assignee: SoftCard Systems, Inc.



) Group Art Unit: 3629

) Examiner: R. S. WOO

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

INFORMATION DISCLOSURE STATEMENT

Pursuant to 37 C.F.R. 1.56, 1.97, and 1.98, Applicant respectfully submits copies of the documents cited on the attached list, which the Examiner may consider to be relevant to the examination of this application. This Information Disclosure Statement is being filed with a Request for Continuing Examination (RCE) and, to Applicant's knowledge, before a subsequent mailing of a first Office Action on the merits or Notice of Allowance.

The listed documents include certain documents cited in the litigation SoftCard Systems, Inc., v. Target Corporation and Visa U.S.A. Inc, Civil Action File No. 1:03-CV-3585-ODE, U.S. District Court, Northern District of Georgia, Atlanta Division, alleging infringement of U.S. Patent No. 6,067,526, issued from the parent application of the instant application; U.S. Patent No. 6,012,038, issued from the grand parent application of the instant application; and U.S. Patent No. 5,890,135, which incorporates by

reference the grand parent application of the instant application, Application Serial No. 08/603,482.

The undersigned attorney has not studied the listed documents to determine their relevance. He has seen, however, that the listed document DEFENDANTS VISA U.S.A. INC.'S AND TARGET CORPORATION'S MEMORANDUM OF LAW IN OPPOSITION TO PLAINTIFF SOFTCARD SYSTEMS, INC.'S MOTION FOR PRELIMINARY INJUNCTION. (document 54 filed with the court clerk's office). According to page 18 of document 54, the undersigned attorney "had deceptive intent . . . thereby rendering the entirety of the '526 Patent - including Claim 7 - invalid."

The undersigned attorney has also seen the listed document DEFENDANTS VISA U.S.A. INC.'S AND TARGET CORPORATION'S INVALIDITY CONTENTIONS. (document 69). According to page 1 of document 69, "The identification of prior art anticipating or rendering certain claim limitations obvious under 35 U.S.C. § 102/103 is based on SoftCard System, Inc's ("SoftCard") preliminary interpretation of these claim limitations as gleaned from SoftCard's infringement contentions, and does not waive any ambiguities or deficiencies identified under 35 U.S.C. Section 112."

Document 69 also states, *inter alia*, "See the Prior Art Invalidity Charts submitted herewith in Appendices I, II and III," and "See the § 112 Chart submitted herewith in Appendix IV." For the convenience of the Examiner, Applicant submits copies of APPENDIX I TO DEFENDANTS' INVALIDITY CONTENTIONS (U.S. PATENT 6,012,038), and APPENDIX III TO DEFENDANTS' INVALIDITY CONTENTIONS (U.S. PATENT NO. 6,607,526), as well as documents cited therein.

Applicant respectfully requests that the Examiner consider each listed document and evidence that consideration on the list.

If the Examiner wishes further materials from this litigation, the Examiner is invited to contact the undersigned attorney at 703-684-4840.

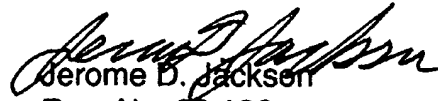
Furthermore, a list of other documents filed with the court, as well as the documents themselves, may be viewed at the U.S. District Court web site [www.gand.uscourts.gov/Pacer.htm](http://www.gand.uscourts.gov/Pacer.htm).

This Information Disclosure statement is not a representation that a search has

been made or that no better art exists. This Information Disclosure statement is not an admission that any of the listed documents are Prior Art, or that Applicant necessarily agrees with any statements in the listed documents.

If there are any other fees required for consideration of this Statement that are not enclosed, please charge such fees to the undersigned attorney's Deposit Account No. 10-0077.

Respectfully submitted,

  
Jerome D. Jackson  
Reg. No. 33,186

Jackson Patent Law Office  
211 N. Union Street, Suite 100  
Alexandria, Virginia 22314

Telephone 703-684-4840  
Facsimile 703-995-0318

DATED: 7 MAY 05

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**U.S. PATENT DOCUMENTS**

Examiner Initials	Document Number	Publication Date	Name	Filing Date

**Examiner Initials**      **OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)**

DEFENDANTS VISA U.S.A. INC.'S AND TARGET CORPORATION'S  
 MEMORANDUM OF LAW IN OPPOSITION TO PLAINTIFF SOFTCARD  
 SYSTEMS, INC.'S MOTION FOR PRELIMINARY INJUNCTION, filed with clerk's office August 5, 2004.

DEFENDANTS VISA U.S.A. INC.'S AND TARGET  
 CORPORATION'S INVALIDITY CONTENTIONS, filed with clerk's office September 2, 2004.

APPENDIX I TO DEFENDANTS' INVALIDITY CONVENTIONS  
 (U.S. PATENT 6,012,038), filed with clerk's office September 2, 2004.

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**U.S. PATENT DOCUMENTS**

Examiner Initials	Document Number	Publication Date	Name	Filing Date
	5,710,887	1/ 20/98	Chelliah et al.	8/29/95
	5,855,007	12/29/98	Jovicic et al.	11/15/95
	5,353,218	10/4/94	De Lapa et al.	9/17/92
	5,708,782	1/13/98	Larson et al.	12/2/94
	5,176,224	1/5/93	Spector et al.	9/28/89
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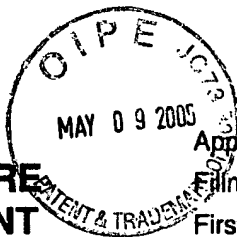


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APPENDIX III TO DEFENDANTS'

INVALIDITY CONTENTIONS (U.S. PATENT NO. 6,607,526), filed with clerk's office Sept. 2, 2005.

"Warner Bros. Online opens entertainment multiplex on the World Wide Web," Business Wire, January 17, 1996.

"Pouring cash into the Internet," Wilder, Clinton, InformationWeek, No. 560, January 1, 1996.

"ON Technology launches first World Wide Web catalog focusing exclusively on tools for Novell networks," PR Newsire, August 11, 1995.

"Catalink Direct's 'Online PC Catalog' adds web service," Newsbytes News Network, April 7, 1995.

"Spinning a better web. (Internet computer network)," Technology Review, Massachusetts Institute of Technology Alumni Association, Vol. 98, No. 3, April 1, 1995.

"North American CAD opens Internet storefront," Newsbytes News Network, March 3, 1995.

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"Sony launches web online offering," Newsbytes News Network, February 16, 1995.

"Carriers set their sights on managed services for carriers to strike outsourcing gold, net managers will have to buy what they're Belting," Robin Gareiss, Data Communications, Vol. 23, No. 17, November 21, 1994.

"Ready for the online bookstore?," Publisher's Weekly, Vol. 241, No. 38, September 19, 1994.

"Web-Server challenge management roles get complicated as servers proliferate," R. Scott Raynovich, LAN Times, Vol. 13, No. 2, January 22, 1996.

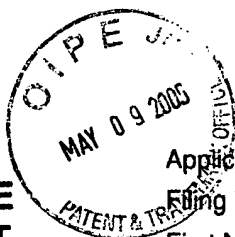
MMAC's Viewpoint Systems enters agreement with Boca Research, Multimedia Networking Newsletter, Multimedia Networking Newsletter, Vol. 3, No 12, January 15, 1996.

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 ISSN: 1047-3149, December 1, 1995.

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HARDWARE: Plug and play security solution, dot.COM, Vol. 2, No. 10, January 1, 1996.

Hat IPO Pace is expected to resume, Molly Baker, The Wall Street Journal, January 2, 1996.

Tools help iron out security wrinkles, Corner, Louis, No. 592, January 15, 1996.

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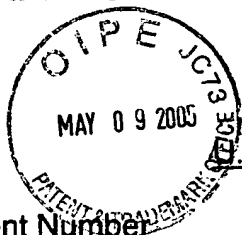
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Internet pioneer eyes cable. IPaul Baron), Leslie Ellis, Multichannel News, Vol. 16, No. 6, ISSN: 0276-8593 February 6, 1995.

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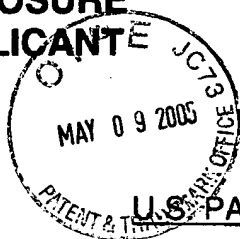
Cable TV joins LANs to the Internet ; the school/cable connection. (the Lexington, MA, Public School Disctrict uses LANcity's muter technology to link its NetWare and AppleTalk Ethenet LANs over existing cable TC lines)(Brief Article), LAN Magazine, Vol. 9, No. 12, ISSN: 1069-5621, November 1, 1994.

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	5,884,277	3/16/99	Khosla	5/1/95
	5,710,887	1/20/98	Chelliah et al.	8/29/95
	5,799,157	8/25/98	Escallon	12/13/94
	5,802,320	9/1/98	Baehr et al.	5/18/95
	5,519,704	5/21/96	Farinacci et al.	4/21/94
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	60/466,270		Narasimhan et al.	6/6/95
	5,500,681	3/19/96	Jones	5/24/94
	3,959,624	5/25/76	Kaslow	12/13/74
	5,249,044		Von Kohorn et al.	5/9/92
	5,789,732	8/4/98	McMahon et al.	6/8/95

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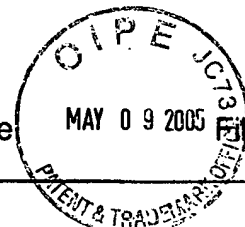
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